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EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/498,698

Applicant(s)

LEE, REID

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 89-134 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 89-134 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to the Applicant's amendment C, paper number 12, filed on December 15, 2003. Claims 89-134 are pending and will be considered for examination.

Final Rejection

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 89-98, 100-103, 106, 108-121, 123-126, 129-131, 133, and 134 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of Motomiya et al (US 6,083,267) and further in view of Risk (US Patent 5,673,434).

Referring to claims 89-92, 97, 98, 100-103, 106, 108-114, 119, 120, 121, 123-126, and 129-134, Henson teaches a method and system for enabling a user to configure a computer system in an e-commerce system, wherein the e-commerce system includes a client system coupled through a network to an electronic commerce server, the method and system comprising:

- receiving a request from a user of the client system to configure the computer system, wherein the product includes one or more customizable components

(column 4, lines 36-52), wherein at least one of the customizable components is a measurement device (Figure 3A and 4). The Examiner notes that Henson allows a user to configure a speaker which is inherently a measurement device (transducer) since it converts electrical energy into acoustic energy.

- providing customizable component options of the customizable components to a client system for display after receiving said request (Figures 3A, 3B, 4, and 5; column 6, lines 18-43). The Examiner notes that once a user clicks on the selection arrow (Figure 4, item "82") a menu opens up which provides a display of the customizable component options of the customizable components.
- receiving customizable component selections for at least one of the one or more customizable components of the computer system in response to user input, wherein the customizable component selections applied to the computer system specify a configured computer system (Figures 3A, 3B, 4, and 5; column 6, lines 18-43).

Henson does not teach that the computer system is a measurement system. However the Examiner notes that a computer system is an art recognized equivalent for a measurement system. To support this point, the Examiner cites the references Mitchell et al (US Patent 5,710,727) and IEEE Spectrum. Mitchell teaches that virtual instruments (i.e. computers) have replaced stand-alone hardware instruments (i.e. oscilloscopes, pressure sensors, etc.) (column 1, line 30 – column 2, line 11). IEEE Spectrum teaches that a virtual instrument has the look and feel of physical instrument and that the software becomes the instrument (page 56, column 2). Therefore it would

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have been obvious to one of ordinary skill in the art, at the time the invention was made, to use Henson's system and method to configure a measurement system. One of ordinary skill in the art would have been motivated to do so in order to obtain performance efficiencies as taught by Mitchell. Henson also does not teach providing an image of the configured system to the client system for display, wherein the image of the configured system visually depicts the customizable component selections of the user. However, Motomiya teaches displaying an image of the customized product to the client system wherein the image of the customized product visually depicts the customizable component selections of the user at their respective locations on the image of the customized product (column 5, lines 41-67; column 6, lines 1-35; Figure 6A, item 63). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and system of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide the customer of Henson's system and method with a visual display of the custom configured product. Motomiya also teaches providing customizable component selection images corresponding to the customizable component selections of the user (Figure 6A, item "62"), visually depicting a subset of the customizable component selection images at their respective locations on the image of the configured product (Figure 6B), and displaying a subset of the customizable component selection images in the image of the configured product (Figure 6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and

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system of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a more natural and easier-to-use design interface.

Referring to claims 93 and 115, Henson and Motomiya do not teach providing text corresponding to the customizable component selections of the user, or that the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured product. However, Risk teaches these limitations (Figure 2, column 1, lines 22-29). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Risk into the method and system of Henson and Motomiya. One of ordinary skill in the art would have been motivated to do so in order to allow a user to personalize the product, as taught by Risk

Referring to claims 94 and 116, Motomiya teaches that the image of the configured product appears substantially like the product (Figures 6A and 6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the method and system of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide the user with an image of the actual configured product.

Referring to claims 95 and 117, Motomiya teaches that the image of the configured product is viewable by the user (Figure 6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method and system of Henson. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see the

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configured product. Henson and Motomiya do not teach that the configured product is used by the user to evaluate and confirm the customizable component selections. However, IEEE Spectrum teaches that LabVIEW allows a user to create a virtual instrument that has functional icons which contain instrument variables, measurement commands, and output designations (page 56, column 2). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IEEE Spectrum into the system and method of Henson and Motomiya. One of ordinary skill in the art would have been motivated to do so in order to allow a user to interact with the configured product.

Referring to claims 96 and 118, Motomiya teaches receiving one or more new customizable component selections for at least one of the one or more customizable components of the configured product after said providing the image of the configured product to the client system, wherein the new customizable component selections applied to the configured product specify a new product, and providing an image of the new configured product, wherein the image of the new configured product visually depicts the new customizable component selections of the user (Figures 5A and 5B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see the product as it was being configured.

Claims 89-134 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of Barad et al (US 6,206,705 B1) and further in view of Risk (US Patent 5,673,434) and IEEE Spectrum.

Referring to claims 89-92, 97, 98, 100-103, 106, 108-114, 119, 120, 121, 123-126, and 129-134, Henson teaches a method and system for enabling a user to configure a computer system in an e-commerce system, wherein the e-commerce system includes a client system coupled through a network to an electronic commerce server, the method and system comprising:

- receiving a request from a user of the client system to configure the computer system, wherein the product includes one or more customizable components (column 4, lines 36-52), wherein at least one of the customizable components is a measurement device (Figure 3A and 4). The Examiner notes that Henson allows a user to configure a speaker which is inherently a measurement device (transducer) since it converts electrical energy into acoustic energy.
- providing customizable component options of the customizable components to a client system for display after receiving said request (Figures 3A, 3B, 4, and 5; column 6, lines 18-43). The Examiner notes that once a user clicks on the selection arrow (Figure 4, item "82") a menu opens up which provides a display of the customizable component options of the customizable components.
- receiving customizable component selections for at least one of the one or more customizable components of the computer system in response to user input, wherein the customizable component selections applied to the computer system

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specify a configured computer system (Figures 3A, 3B, 4, and 5; column 6, lines 18-43).

Henson does not teach that the computer system is a measurement system. However the Examiner notes that a computer system is an art recognized equivalent for a measurement system. To support this point, the Examiner cites the references Mitchell et al (US Patent 5,710,727) and IEEE Spectrum. Mitchell teaches that virtual instruments (i.e. computers) have replaced stand-alone hardware instruments (i.e. oscilloscopes, pressure sensors, etc.) (column 1, line 30 – column 2, line 11). IEEE Spectrum teaches that a virtual instrument has the look and feel of physical instrument and that the software becomes the instrument (page 56, column 2). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use Henson's system and method to configure a measurement system. One of ordinary skill in the art would have been motivated to do so in order to obtain performance efficiencies as taught by Mitchell. Henson also does not teach providing an image of the configured system to the client system for display, wherein the image of the configured system visually depicts the customizable component selections of the user. However, Barad teaches displaying an image of the customized product to the client system wherein the image of the customized product visually depicts the customizable component selections of the user at their respective locations on the image of the customized product (Figures 13-17, 21, and 22; column 1, line 28 – column 4, line 9). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Barad into the method and

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system of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide the customer of Henson's system and method with a visual display of the custom configured product. Barad also teaches providing customizable component selection images corresponding to the customizable component selections of the user (Figures 7, 15, and 16), visually depicting a subset of the customizable component selection images at their respective locations on the image of the configured product (Figure 16), and displaying a subset of the customizable component selection images in the image of the configured product (Figure 16). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Barad into the method and system of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a more natural and easier-to-use design interface.

Referring to claims 93 and 115, Henson and Barad do not teach providing text corresponding to the customizable component selections of the user, or that the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured product. However, Risk teaches these limitations (Figure 2, column 1, lines 22-29). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Risk into the method and system of Henson and Barad. One of ordinary skill in the art would have been motivated to do so in order to allow a user to personalize the product, as taught by Risk.

Referring to claims 94 and 116, Barad teaches that the image of the configured product appears substantially like the product (Figure 1, item "28a"). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Barad into the method and system of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide a user with an image of the actual configured product.

Referring to claims 95 and 117, Barad teaches that the image of the configured product is viewable by the user (Figure 1, item "28a"). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method and system of Henson. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see the configured product. Henson and Barad do not teach that the configured product is used by the user to evaluate and confirm the customizable component selections. However, IEEE Spectrum teaches that LabVIEW allows a user to create a virtual instrument that has functional icons which contain instrument variables, measurement commands, and output designations (page 56, column 2). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IEEE Spectrum into the system and method of Henson and Barad. One of ordinary skill in the art would have been motivated to do so in order to allow a user to interact with the configured product.

Referring to claims 96 and 118, Barad teaches receiving one or more new customizable component selections for at least one of the one or more customizable

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components of the configured product after said providing the image of the configured product to the client system, wherein the new customizable component selections applied to the configured product specify a new product, and providing an image of the new configured product, wherein the image of the new configured product visually depicts the new customizable component selections of the user (Figures 15 and 16). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see the product as it was being configured.

Referring to claims 99 and 122, Henson and Barad do not teach that a cursor of the client system overlaps the location of the image of the first customizable component displayed in the image of the product. However Barad teaches that a user uses a browser interface to interact with the system. Barad also teaches that the user must "click" on various components to configure the components. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to allow a user to configure a component by using a cursor to overlap the location of the image of a customizable component. One of ordinary skill in the art would have been motivated to do so in order to provide a user with a more natural interface.

Referring to claims 104, 105, 107, 127, and 128, Barad teaches providing a sequence of images corresponding to the customizable component options of the first customizable component after said receiving user input selecting the image of the first customizable component (Figure 14). Therefore it would have been obvious to one of

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ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Barad into the method of Henson. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see and interact with the customizable components.

Response to Arguments

Applicant's arguments filed December 15, 2003 have been fully considered but they are not persuasive. In response to Applicant's argument that Henson, Motomiya, and Barad are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Henson, Motomiya, and Barad are all directed to configuring a product on-line. The motivation to combine comes from the references since each one provides a user with different features during the customization process such as product layout, component selection, menu selection, and visual display. One of ordinary skill in the art, at the time of the invention, would have understood that the difference between the cited references is merely one of presentation and selection of data. Furthermore, one of ordinary skill would have realized that features from one reference are capable of being combined with features from the other two references since all three are analogous art that are directed to the problem area of assisting a user in customizing or configuring a product on-line. Merely

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replacing one product (i.e. a computer system, jewelry, or toy) with another product (i.e. a measurement system) is well within the level of one of ordinary skill in the art. The Applicant has also argued that his invention is directed to a measurement system whereas the prior art of record is directed to a computer system. The Applicant asserts that the problem of customizing a computer system is different from the problem of customizing a measurement system since Henson's computer system would still require additional hardware or software such as a data acquisition card or signal generator in order to function as a measurement system. However, the Examiner notes that the claim language does not recite "data acquisition card" or "signal generator". Instead, the claims use the term "component" which can be any component such as a memory module. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the present case, Henson teaches that a variety of both hardware and software components are customizable (Figure 4). Finally, the Applicant has argued that Risk is not analogous art since Risk teaches that text is used for adornment purposes. However, the Examiner notes that the Applicant's use of text on the customizable component is also used for adornment purposes since the text itself does not affect the component in any way. A memory module will still be a memory module whether or not there is text that says "memory module". Nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.

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1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

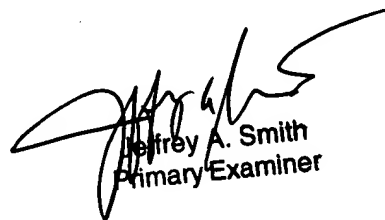
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625

March 25, 2004



Jeffrey A. Smith
Primary Examiner